

Amendments to the Drawings:

Two sheets of drawings respectively including changes to FIGS. 3 and 11 are appended hereto.

In the attached Replacement Sheet for FIG. 3, the label PRIOR ART has been inserted beneath the figure number.

In the attached Replacement Sheet for FIG. 11, the distal open end item previously labeled "412.1" of the tool guide 410 is now labeled --412.2--.

REMARKS/ARGUMENTS

In the Non-Final Office Action of September 7, 2005 (the "Office Action"):

1. Affirmation of the election to prosecute Group 1 claims is requested;
2. The Drawings are objected to;
3. The Specification is objected to;
4. Claim 6 is rejected under 35 USC 112, 2nd paragraph;
5. Claims 1-11 and 16-17 are rejected under 35 USC 102(b) as being anticipated by U.S. 5,320,611 issued to Bonutti;
6. Claims 18-23 and 25-29 are rejected under 35 USC 102(e) as being anticipated by U.S. 4,655,752 issued to Honkanen et al. ("Honkanen");
7. Claims 1-2, 7-10, 12-15, 18-22, 30 and 31 are rejected under 35 USC 102(e) as being anticipated by U.S. 6,726,699 issued to Wright et al. ("Wright"); and
8. Claims 18-24 are rejected under 35 USC 102(e) as being anticipated by U.S. 6,224,608 issued to Ciccolella et al. ("Ciccolella").

1. Restriction Requirement

Affirmation of the prior stated election to prosecute Group 1, Claims 1-31 is hereby made. Accordingly, Claims 31-32 of Group 2 are herein cancelled without prejudice.

2. Objection to the Drawings

The drawings are objected to because reference character "412.1" has been used to designate both open ends of the tool guide. Accordingly, FIG. 11 has been amended (and a Replacement Sheet provided herein) so that the distal open end has been changed from "412.1" in the original sheet to --412.2-- in the Replacement Sheet, as suggested in the Office Action.

In addition, FIG. 3 was objected to as requiring a legend such as --Prior Art-- because only that which is old is illustrated. Accordingly, FIG. 3 has been amended (and a Replacement Sheet provided herein) so as to include such legend beneath the figure number.

3. Objection to the Specification

The Abstract has been amended, and as amended, is believed to overcome the objections set forth in the Office Action.

4. Rejection of Claim 6 under 35 USC 112, 2nd Paragraph

Claim 6 has been cancelled. Therefore, rejection of this claim is no longer an issue.

5. Rejection of Claims 1-11 and 16-17 under 35 USC 102(b)

Claims 1-11 and 16-17 have been cancelled. Therefore, rejection of these claims is no longer an issue.

6. Rejection of Claims 18-23 and 25-29 under 35 USC 102(e) in light of Honkanen

As recited in amended Claim 18, applicants' engaging formation is "arranged to hold and provide a stop for a complementary engaging formation on a robotic arm," and this aspect of the claim is neither taught nor suggested by Honkanen.

In Honkanen, the bore 40 of the lower section 15 of the surgical cannula appears to be smooth. See, e.g., FIG. 2. It therefore, does not "provide a stop for a complementary engaging formation on a robotic arm". Further, if an engaging formation on a robotic arm were to be inserted in the surgical cannula, it would not be desirable according to the teaching of Honkanen for it to engage the bore 40, because that would close off the bore 40 to fluid flow and prevent the cannula from being used as an irrigation cannula as well as an instrument cannula. See, e.g., Col. 5, lines 26-34.

Accordingly, Claim 18 is believed to be patentable under 35 USC 102(e) over Honkanen for the foregoing reasons, and Claims 19, 21-23 and 25-29 are also believed to be patentable under 35 USC 102(e) over Honkanen since they depend from Claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 18. Claim 20 has been cancelled, and its limitation included in Claim 18.

7. Rejection of Claims 1-2, 7-10, 12-15, 18-22, 30 and 31 under 35 USC 102(e) in light of Wright

Wright shows a surgical instrument 12 extending through an instrument guide 24, which in turn, extends through a trocar 26 inserted into a patient. See, e.g., FIG. 1 and Col. 2, lines 38-41. The instrument guide 24 is also shown to be attached to a robotic arm. See, e.g., FIG. 1 and Col. 3, lines 8-11. Like Honkanen, however, Wright also fails to teach or suggest applicants' engaging formation which is "arranged to hold and provide a stop for a complementary engaging formation on a robotic arm," since the inner walls of Wright's instrument guide 24 also appears to be smooth.

Accordingly, Claim 18 is believed to be patentable under 35 USC 102(e) over Wright for the foregoing reasons, and Claims 19, 21-22, 30 and 31 are also believed to be patentable under 35 USC 102(e) over Wright since they depend from Claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 18. Claims 1-2, 7-10, 12-15, and 20 have been cancelled, and therefore, any rejection of these claims is no longer of issue.

9. Rejection of Claims 18-24 under 35 USC 102(e) in light of Ciccolella

Ciccolella shows an inner housing 40 and outer housing 42 which cooperate to frictionally engage and grasp a guide tube 28 disposed within the two housings. See, FIG. 3 and Col. 4, lines 44-61. Although the outer housing 42 has a vertical stop wall 78 and a camming surface 76 to engage gripping finger camming surface 62 of the inner housing, the vertical stop wall 78 and camming surface 76 are not defined within the passage of the body (which is asserted in the Office Action to be elongate tube portion 68 of the outer housing 42), and therefore, do not teach the engaging formation as recited in Claim 18. Also, the gripping finger camming surface 62 is not on a robotic arm, and therefore, does not teach the complementary engaging formation as recited in Claim 18.

In FIG. 6 of Ciccolella, although the elongated guide tube surrounding section 68 is shown extending from the guide tube housing 30, the connection is integrally formed. See, Col. 8, lines 11-14. There is no teaching in this arrangement of an engaging formation within the passage of the elongated guide tube surrounding section 68 which is

arranged to "hold and provide a stop for a complementary engaging formation on a robotic arm."


Accordingly, Claim 18 is believed to be patentable under 35 USC 102(e) over Ciccolella for the foregoing reasons, and Claims 19 and 21-24 are also believed to be patentable under 35 USC 102(e) over Ciccolella since they depend from Claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 18. Claim 20 has been cancelled, and its limitation included in Claim 18.

Conclusion

Claims 18, 19, and 21-31 remain pending in the application. Claims 1-17, 20, and 32-33 have been cancelled. Reconsideration of the rejection of the pending claims is respectfully requested, and an early notice of their allowance earnestly solicited.

Respectfully submitted,

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